

REMARKS/ARGUMENTS

Claims 1-24 are pending in the present application.

This Amendment is in response to the Office Action mailed April 21, 2008. In the Office Action, the Examiner rejected claims 1-24 under 35 U.S.C. §103(a).

Reconsideration in light of the remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-3, 5-7, 9-11, 13-15, 17-19, and 21-23 under 35 U.S.C. §103(a) as being allegedly obvious over U.S. Patent No. 5,867,226A issued to Wehmeyer et al. (hereinafter Wehmeyer) in view of U.S. Patent No. 6,522,342B1 issued to Gagnon et al. (hereinafter Gagnon) and even further in view of U.S. Patent No. 6,564,379B1 issued to Knudson et al. (hereinafter Knudson).

Applicant respectfully traverses the rejection and submits that the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143.

The Supreme Court in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966), stated: "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined." MPEP 2141.

In KSR International Co. vs. Teleflex, Inc., 127 S.Ct. 1727 (2007) (Kennedy, J.), the Court explained that "[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." The Court further required that an

explicit analysis for this reason must be made. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR, 127 S.Ct. at 1741, quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006).

Further, as is well known in obviousness determinations, *impermissible hindsight must be avoided*. MPEP § 2141. To defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. Interconnect Planning Corp. v. Feil, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453.

Applicant respectfully submits that there is no suggestion or motivation to combine Wehmeyer, Gagnon, and Knudson, and thus no *prima facie* case of obviousness has been adequately established. Further, even if Wehmeyer, Gagnon, and Knudson were properly combinable, their combination would not teach suggest the limitations of independent claims 1, 9, and 17.

In the instant case, Applicant respectfully submits that there are significant differences between the cited Wehmeyer, Gagnon, and Knudson references and the claimed invention and there is no apparent reason to combine the known elements in the manner as claimed (except for impermissible hindsight), and thus a *prima facie* case of obviousness has not been adequately established.

Wehmeyer is merely cited because it discloses a set-top box and a program guide.

As admitted by the Examiner, Wehmeyer does not disclose icons as identifiers (Office Action, page 4). Thus, as the Examiner acknowledges, Wehmeyer does not teach or suggest at least the elements: (1) displaying an arrangement of a plurality of different channel icons associated with respective video program providers in a plurality of rows and columns simultaneously on the display device; (2) selecting one of the plurality of different channel icons

in response to the first input; and (3) displaying a pop-up for the selected channel icon on the display device while still displaying the arrangement of the plurality of different channel icons, the pop-up overlaying at least one other channel icon; wherein: (4) the pop-up displays the first program data associated with the first program of the selected channel icon in response to the first input and the user interface receives the second input while the pop-up is displaying the first program data; and (5) the pop-up displays the second program data associated with the second program of the selected channel icon in response to the second input while the arrangement of the plurality of different channel icons in the plurality of rows and columns is still displayed and the pop-up continues to overlay the at least one other channel icon, as recited in claims 1, 9, and 17.

The Examiner then alleges that Gagnon teaches the use of icons as identifiers, citing Figures 5 and 7 of Gagnon. (Office Action, page 5).

Applicant respectfully disagrees with the Examiner. Applicant respectfully submits that Gagnon does not teach or suggest channels icons as set forth in independent claims 1, 9, and 17.

Gagnon merely discloses a Best-of-Web data service page (Gagnon, col. 6, lines 35-42; Figures 5 and 7). Figures 5 and 7 are examples of the Add Selections sub-page 208 and the My Selections sub-page 206 displays, respectively. The special links segment 186 contains a plurality of graphics or logos that represent topical or otherwise noteworthy websites that are mandatory download websites. Mandatory download websites are regularly/periodically downloaded and stored in the local memory of the user's PC 128 (Gagnon, col. 13, lines 32-41).

In contrast, independent claims 1, 9, and 17 generally recite that *the plurality of different channel icons are associated with respective video program providers*. The video program providers may be a broadcast television networks or cable networks (See Specifications, page 4, line 24, for further details).

Because website logo 224 of Gagnon represents a website (Gagnon, col. 13, line 65). Gagnon in no way teach or suggests a channel icon associated with a video program provider.

As to Knudson, Knudson merely discloses a user operating the program guide in either a browse mode or flip mode by using the cursor keys for browse mode and channel up and down keys for flip mode (Knudson, col. 7, lines 4-7, Figures 4 and 5), and does not teach or suggest "selecting one of the plurality of different channel icons in response to the first input," as recited in the claims.

As illustrated in Figures 4 and 5 of Knudson, the browse display 70 contains the program listing information for the current channel and time and if the user presses a cursor key, the program listings information in the browse display 70 is changed (Knudson, col. 6, lines 33-40). The browse display 70 is not equivalent to a channel icon.

Icons are on-screen representations which, in the present invention, are associated with respective video program providers. The browse display 70 providing program listings information, as illustrated in Figures 4 and 5 of Knudson, is not a channel icon.

As discussed above, the combination of Wehmeyer, Gagnon, and Knudson does not teach or suggest the limitations of independent claims 1, 9, and 17. Further, the proposed combination of Wehmeyer, in view of Gagnon, and even in further in view of Knudson is improper.

There are significant differences between the cited references and the claimed invention as discussed above. Furthermore, the Examiner has not made an explicit analysis on the apparent reason to combine the known elements in the fashion of the claimed invention and is relying on impermissible hindsight reconstruction. Accordingly, there is no apparent reason to combine the teachings of Wehmeyer, in view of Gagnon, and even in further in view of Knudson.

Therefore, Applicant respectfully submits that independent claims 1, 9, and 17 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. §103(a) be withdrawn and that independent claims 1, 9, and 17, and their respective dependent claims, be allowed and passed to issuance.

Conclusion

In view of the remarks made above, it is respectfully submitted that pending claims 1-24 are allowable over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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By



Eric T. King

Reg. No. 44,188

Tel.: (714) 557-3800 (Pacific Coast)

1279 Oakmead Parkway,
Sunnyvale, CA 94085-4040